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OFFICE OF PETITIONS

In re Application of	:
Chung Yi-Chen	:
Application No. 10/763,572	:
Filed: January 23, 2004	:
Attorney Docket No.: 9182.0005-00	:
Title: INTERPOLATIVE INTERLEAVING OF VIDEO IMAGES	:

This is a decision on the petition filed on March 8, 2007, pursuant to 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 21, 2006, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees¹. Accordingly, the above-identified application became abandoned on December 22, 2006. A Notice of Abandonment was mailed on January 22, 2007.

¹ See MPEP §710.02(e).

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. §1.4(c) sets forth, *in toto*:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

MPEP 402.06 states, *in pertinent part*:

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. The **withdrawal is effective when approved** (emphasis included) rather than when received.

MPEP 711.03(c) states, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of

abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 2d, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment. Petitioner has asserted that he failed to receive the Notice of Allowance and Issue Fee Due.

The timeline of relevant events is as follows:

- November 22, 2005: a request for withdrawal of power of attorney was filed by the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner LLP (Finnegan). The request further set forth that all future correspondence should be sent to "Jeff Toler, IP Legal Services, 5000 Plaza on the Lake, Suite 265, Austin, Texas, 78746" (IP Legal Services).
- September 8, 2006: a decision was mailed on this request, indicating that the request was not approved. The decision was mailed to the address of record (Finnegan), and a copy was mailed to IP Legal Services.
- September 21, 2006: a Notice of Allowance and Issue Fee Due was mailed to Finnegan.
- January 22, 2007: a Notice of Abandonment was mailed to Finnegan.

With this petition, Petitioner has asserted that the application "is not in fact abandoned" because the Notice of Allowance and Issue Fee Due was not timely received by Petitioner (Jeffrey G. Toler, formerly of IP Legal Services). It is noted in passing that it does not appear that Mr. Toler has updated his address with the Office.

It is further noted in passing that although Finnegan attempted to change the correspondence address to IP Legal Services with the submission of November 22, 2005, this request was improper. Finnegan attempted to file both the request for withdrawal of power of attorney and the change of correspondence address as a single submission. This was improper, pursuant to 37 C.F.R. §1.4(c).

Petitioner has further set forth that he became aware of both the Notice of Allowance and Issue Fee Due and the notice of

abandonment upon receiving a letter from Finnegan on February 7, 2007, which included a copy of the Notice of Abandonment. Consequently, he was not aware of the Notice of Allowance and Issue Fee Due until after the expiration of the period for response.

As such, Petitioner has indicated that the Office communication in question was not received by the practitioner. Petitioner has further included a declaration of facts which includes a statement which implies that a search of the file jacket and docket records indicates that the Office communication was not received (from Finnegan). Finally, Petitioner has included a copy of the docket record where the nonreceived Office communication would have been entered had it been received (from Finnegan) and docketed.

Clearly, Petitioner is attempting to meet the requirements of Delgar v. Schulyer, as delineated in MPEP §711.03(c)(I)(A), reproduced above. However, the Delgar requirements are not relevant to the pertinent case, in that the Office did not mail the relevant communication to Petitioner. In Delgar, the Office mailed a notice of allowance to the applicant, and the Delgar showing provides a mechanism by which applicants can establish that a mailing was not received from the Office. Petitioner is attempting to establish that a mailing was not received from another law firm, a situation which is outside of the scope of Delgar.

CONCLUSION

Pursuant to the above discussion, the petition must be **DISMISSED**.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C 704. The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail², hand-delivery³, or facsimile⁴.

² Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

³ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁴ (571) 273-8300- please note this is a central facsimile number.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b). No assurance can be made that any remedy will be forthcoming.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225⁵. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate that a change of correspondence address has been properly filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.



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5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).